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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re application of

Shinichi OSHIMA

Appln. No.: 08/988,181

Group Art Unit: 3711

Confirmation No.: Not Assigned

Examiner: Raeann Gorden

Filed: December 10, 1997

For: GOLF BALL SELECTION DEVICE

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TC 3700 MAIL ROOM

SUBMISSION OF APPELLANT'S BRIEF ON APPEAL

Commissioner for Patents
Washington, D.C. 20231

Sir:

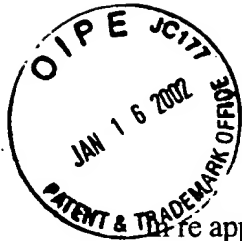
Submitted herewith please find an original and two copies of Appellant's Brief on Appeal. You are hereby authorized to charge Deposit Account No. 19-4880 for the statutory fee of \$320.00. Authorization is also given to charge or credit any difference or overpayment to Deposit Account No. 19-4880. A duplicate copy of this paper is attached.

Respectfully submitted,

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Date: January 16, 2002



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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §1.192

Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant submits the following:

I. REAL PARTY IN INTEREST

The real party in interest is Bridgestone Sports Co., Ltd., the owner by assignment of all rights and interest in the present application.

II. RELATED APPEALS AND INTERFERENCES

Bridgestone Sports Co., Ltd. is also the owner by assignment of co-pending application (Serial No. 09/060,960), which is a continuation-in-part of the present application (Serial Number 08/988/181). Appeal of a final rejection issued in co-pending application (Serial No. 09/060,960) has been made and an appeal brief is being filed on this date.

III. STATUS OF CLAIMS

Claims 1-11 have been canceled. Claims 12-43 are pending, and all have been finally rejected in the Office Action (Paper No. 16, mailed July 16, 2001). Claims 12-43 are appealed.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the final rejection contained in the Office Action (Paper No. 16, mailed July 16, 2001).

V. SUMMARY OF THE INVENTION

The present invention is related to a package for golf balls. The package includes a generally rectangular indication section or label formed on the package for indicating a plurality of performance characteristics of the golf ball that is enclosed within the package. The section includes two or more sub-sections, which in turn include an icon and a set of descriptive information to identify and specify performance characteristics of the golf ball. Performance characteristics of the golf ball include, by way of example, golf ball structure, recommended head speed, feel, spin, green targeting, trajectory and distance.

As was common practice in the art, golf balls were marked with an indication of hardness (e.g., PGA compression). (application, p. 1.) However, such information does not provide the golfer with sufficient information to inform him of the characteristics of the golf ball, and thus the golfer is not able to select the ball best suited for his game. (Id. at p. 2). In fact, each golf

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ball cannot be characterized by a single function or mark. Instead, the performance and characteristics of a golf ball is defined by a number and combination of various factors.

Accordingly, the present invention provides a novel way of informing the golfer of the type of golf ball enclosed within a certain package. The invention takes into account various combinations of factors, performance characteristics, etc. that are important to a golfer in selecting the proper golf ball that is best suited to his game/style of golf.

Figure 1 shows a golf ball box having a body 2 for receiving a dozen golf balls (not shown) and a cover 3 designed to fit over the body 2. An indication section 4 is printed or otherwise formed on the outer surface of the cover 3 for indicating the performance of the golf ball enclosed within the package. (p. 7.)

Figure 2 illustrates in further detail the indication section 4. There, the section is shown as a rectangular block defined and delimited by a rectangular boundary line 5. The section 4 is divided into a plurality of sub-sections 7, forming a matrix of rows and columns. (p. 8.) The sub-sections 7 in one group or row are provided with marks 8 belonging to the same function or performance characteristic, but each indicates different functional species. One of the marks is selected for each group or row in accordance with the performance of the golf ball.

For example, the first row or group A includes six sub-sections 7 to which are attached marks 8 belonging to the golf ball structure and which indicate whether the ball is a thread wound ball or a two- or three-piece ball, whether the wound ball has a liquid or solid center, or has a balata cover or a Surlyn cover, whether the cover is a double cover, and whether the ball is a soft type or a spin type. The other rows provide the golfer with even yet more information

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about the characteristics of the ball, so that a more intelligent decision can be made when purchasing the balls.

Figures 3 to 6 illustrate another embodiment of a package designed to hold three balls (a sleeve) and an example of an indication section that may be used on the smaller package.

As various functions characterizing the ball are displayed, the golfer can select the proper golf ball by taking into account many factors. The indications are provided in a manner that a golfer can easily understand and glean from the package of the ball taking into account various aspects.

VI. ISSUES

Whether claims 12-43 are unpatentable under 35 U.S.C. §103(a) over Connell (U.S. Patent No. 1,406,541) in view of Taylor (U.S. Patent No. 4,921,255).

VII. GROUPING OF CLAIMS

Claims 12-29 and 31-43 stand or fall together. Claim 30 is separately patentable and does not stand or fall with independent claim 12.

VIII. ARGUMENTS

Claims 12-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Connell in view of Taylor. The Examiner contends that Connell discloses a box with pictures and written descriptions of the contents of the box. The Examiner recognizes that Connell discloses cigar

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(actually pipe) information on the box, but deems this merely to be a difference in “what is attributed to printed matter [which] does not provide a basis on which patentability may be predicted.” (Final Office Action, Paper No. 16, mailed July 16, 2001.)

The Examiner relies on Taylor, as a secondary reference, for teaching golf balls having different playing characteristics and for the fact that golf balls are usually sold in boxes having a cover. (*Id.*)

The Examiner concludes that it would have been obvious for one skilled in the art to label a box with pictorial illustrations and descriptive text of each ball since such is a conventional technique for information the golfer of the different golf balls. (*Id.*)

Appellants respectfully disagree with the basis for the rejection of the claims, and submit that the rejection be overturned.

Claims 12-43 are pending. Claims 12 and 31 are independent claims. Claim 12 reads as follows:

12. A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.

Claim 31 reads as follows:

31. A package for receiving a golf ball, said package comprising:

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a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

Accordingly, the present invention requires, as defined by at least claims 12 and 31, an indication section formed on the package for indicating a plurality of performance characteristics of the golf ball. The section must include two or more sub-sections (claim 12) or at least first and second sub-sections (claim 31), each sub-section including an icon and a first set of descriptive information to identify and specify performance characteristics of the golf ball.

Moreover, and importantly, for the very same golf ball in the package, multiple performance characteristics are described and indicated within the indication section. That is, each sub-section provides indications or information about a different attribute of the same golf ball, and collectively the sub-sections provide critical information concerning multiple characteristics of the same golf ball.

In contrast, the primary reference, Connell, discloses a box with pictures and written descriptions of pipes which are contained within the box. Connell, however, fails to teach or suggest providing indications/information about various characteristics of the same pipe that is within the package. Rather, Connell illustrates a package which shows all of the pipes made by the manufacturer, regardless of the type of pipe in the actual package.

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Indeed, Connell expressly states:

“a series of pictorial representations 11, preferably imprinted on the label body 10, the pictorial representations portraying or illustrating the various styles or shapes of pipes made and marketed by the manufacturer.” (Col. 2, lines 10-15.)

* * *

“This design of label not only serves to inform the distributor and retailer of all the styles of pipes manufactured, but the label serves and is suited for packages or containers holding pipes of any particular style, the label therefore being of universal utility as applied to smoking pipes.” (Col. 2, lines 20-26.)

Nowhere does Connell teach or even suggest a manner of providing an indication section that includes sub-sections arranged to provide information about multiple performance characteristics of an object. Connell illustrates all of the types of pipes manufactured. Connell does not provide information about multiple performance characteristics of the one pipe enclosed in the cartoon. For example, Connell does not disclose anything about how the pipe performs when smoked with a type of tobacco; its internal structure, which is critical to performance, or provide any information to pipe smokers so that they can choose the pipe best suited to their likings or puffing needs.

At most, Connell merely provides different pictorial information concerning different shapes of pipes made by the manufacturer. The present invention is significantly different. Here, the invention is not to provide indication sections providing information about all of the different golf balls that are made and sold by a manufacturer. Rather, the invention provides an indication

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sections with sub-sections providing information about multiple characteristics of the same type of golf ball contained in the package.

Furthermore, Connell does not teach or suggest providing information about various characteristics of the enclosed golf ball, but merely provides the picture of all products made the manufacturer, including the product enclosed. This would be tantamount to the golf ball package illustrating a golf ball to illustrate that a golf ball is inside. In this regard, the present invention is clearly distinguishable from the applied art, by requiring much more specific information and type of information to be provided.

Further, claim 30 requires the use of color-encoded identification marks. Clearly, this is neither taught nor suggested in the applied art.

The reliance on the secondary reference, Taylor, fails to make up the many deficiencies of Connell, and the two references lack any motivation or objective reasoning as to why one of skill in the art would combine their teachings. Thus, the combination of Connell and Taylor fails to render the claims unpatentable.

First, Taylor merely relates to the dimple patterns on golf balls and does not have anything to do with how golf balls are sold in boxes or the type of information that is placed on packages to convey to the consumer what type of golf balls are contained within the package. Clearly, outside of the fact that Taylor discloses a golf ball, this reference is irrelevant to this invention.

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Secondly, neither reference provides any objective reasoning or motivation as to why one of skill in the art would combine their teachings, and the Examiner offers none. Nothing within these two references would suggest to one of skill in the art that their teachings can or should be combined. The record is devoid of any such evidence.

Lastly, even in hindsight, if one were to combine the teachings, the present invention as defined by the claims is not taught. The combination of the two references fail to teach or suggest a package having indication sections including sub-sections to provide information about multiple characteristics of the golf ball in the package.

Accordingly, the combination of Connell and Taylor fails to teach or suggest claims 12-43 of the present application. Each of the dependent claims are more specific to the different types of performance characteristics and the number of performance characteristics that are indicated in the subsections on the package. The combination of the art relied upon by the Examiner fails to render unpatentable claims 12-43.

IX. CONCLUSION

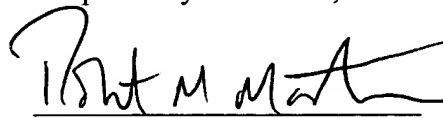
For all of the foregoing reasons, Appellants respectfully request that the rejection of claims 12-43 be reversed.

The present Brief on Appeal is being filed in triplicate. Unless a check is submitted herewith for the fee required under 37 C.F.R. §1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

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Appellants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert M. Masters", written over a horizontal line.

Robert M. Masters
Registration No. 35,603

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Date: January 16, 2002

APPENDIX

CLAIMS 12-43 ON APPEAL:

12. A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball.
13. The package as defined by claim 12, wherein a first performance characteristic relates to the feel of the golf ball when struck by a first type of golf club, and a second performance characteristic relates to the spin rate of the golf ball when struck by a second type of golf club.
14. The package as defined by claim 13, wherein said first set of descriptive information identifies one of said first and second performance characteristics.
15. The package as defined by claim 14, wherein said icon includes a golf ball and golf club depicting and identifying at least one of said first and second performance characteristics.
16. The package as defined by claim 14, wherein said icon includes at least a golf ball depicting and identifying at least one of said first and second performance characteristics.

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17. The package as defined by claim 14, wherein said icon includes a golf ball graphically depicting the spin of a golf ball.

18. The package as defined by claim 14, wherein said icon includes a golf ball and arrows arranged on a periphery of the golf ball for graphically depicting the spin of a golf ball.

19. The package as defined by claim 14, wherein each of said sub-sections further comprises a second set of descriptive information for indicating relative differences of said performance characteristic.

20. The package as defined by claim 13, wherein said first type of golf club is a putter.

21. The package as defined by claim 13, wherein said second type of golf club is an iron type of golf club.

22. The package as defined by claim 13, wherein said first type of golf club is a putter, and said second type of golf club is an iron type of golf club.

23. A package for receiving a golf ball as defined by claim 12, wherein said performance characteristics comprises at least two of ball structure, recommended head speed, feel, spin rate, green targeting, and trajectory.

24. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristics comprises at least four of ball structure, recommended head speed, feel, spin rate, green targeting, and trajectory.

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25. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic recommended head speed is depicted by said first set of descriptive information and said icon representing a recommended range of head speeds to strike the golf ball with a golf ball club.

26. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic green targeting is depicted by said first set of descriptive information and said icon representing whether the green is targeted by spin or height.

27. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic trajectory is depicted by said first set of descriptive information and said icon representing degrees of trajectory when struck by a golf ball club.

28. A package for receiving a golf ball as defined by claim 27, wherein said degrees of trajectory comprise high trajectory, intermediate trajectory, and low trajectory when the golf ball is struck by a golf ball club driver.

29. A package for receiving a golf ball as defined by claim 23, wherein said performance characteristic ball structure is depicted by said first set of descriptive information and said icon representing at least one of whether the golf ball is thread wound or a two-piece golf ball, whether the thread wound ball has a liquid or solid center, the type of cover, whether the cover is a double cover, and whether the two-piece ball is a soft type or spin type.

30. A package for receiving a golf ball as defined by claim 23, wherein at least one of said first set of descriptive information and said icon comprises a color-encoded identification mark.

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31. A package for receiving a golf ball, said package comprising:
a box body;
a cover fitted over said box body; and
a generally rectangular indication section formed on said package for indicating characteristics of the golf ball, said section comprising: a first sub-section comprising a first icon and a first set of descriptive information representative of a first performance characteristic of the golf ball; and a second sub-section comprising a second icon and a second set of descriptive information representative of a second performance characteristic of the golf ball.

32. The package as defined by claim 31, wherein said first performance characteristic relates to the feel of the golf ball when struck by a first type of golf club, and said second performance characteristic relates to the spin rate of the golf ball when struck by a second type of golf club.

33. The package as defined by claim 32, wherein said first set of descriptive information identifies feel as the first performance characteristic of the golf ball; and said second set of descriptive information identifies spin rate as the second performance characteristic of the golf ball.

34. The package as defined by claim 32, wherein said first set of descriptive information identifies feel as the first performance characteristic of the golf ball.

35. The package as defined by claim 32, wherein said second set of descriptive information identifies spin rate as the second performance characteristic of the golf ball.

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36. The package as defined by claim 33, wherein said first and second icons depict at least one of a golf ball and a golf club for identifying said first and second performance characteristics of the golf ball.

37. The package as defined by claim 33, wherein said first icon includes a golf ball and a golf club depicting and identifying the feel of the golf ball.

38. The package as defined by claim 33, wherein said second icon includes a golf ball depicting the spin of the golf ball.

39. The package as defined by claim 33, wherein said second icon includes a golf ball and arrows arranged on a periphery of the golf ball for graphically depicting the spin of a golf ball.

40. The package as defined by claim 33, wherein said first set of descriptive information further comprises information for indicating the amount of feel of the golf ball.

41. The package as defined by claim 33, wherein said first set of descriptive information further comprises information for indicating the amount of feel of the golf ball in different relative degrees of softness.

42. The package as defined by claim 33, wherein said second set of descriptive information further comprises information for indicating the amount of spin of the golf ball when struck by an iron type golf club.

43. The package as defined by claim 33, wherein said second set of descriptive information further comprises information for indicating different relative amounts of spin of the golf ball when struck by an iron type golf club.